

REMARKS

The present amendment is in response to the Office action dated May 18, 2006, where the Examiner has rejected claims 1 – 19. In the present amendment, claims 1 and 7 have been amended and claims 14 – 19 have been cancelled without prejudice. New claims 20 – 28 have been added. Accordingly, claims 1 – 13 and 20 – 28 are pending in the present application with claims 1, 7, 23, and 24 being the independent claims. Reconsideration and allowance of pending claims 1 – 13 and 20 – 28 in view of the amendments and the following remarks are respectfully requested.

A. Rejection of Claims 1 – 19 Under 35 USC §103

In the Office Action, claims 1 – 19 have been rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent Publication No. 2004/0005889 (“Shanahan”) in view of U.S. Patent Publication No. 2002/1023336 (“Kamada”).

The Office Action relies primarily on Shanahan as teaching the elements of the claimed invention and states that the combination of Shanahan with Kamada would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

In the Office Action, no motivation has been cited within either reference that suggests combining the references. The subject matter of the claimed invention is related to wireless communication devices and providing such devices with a connectivity toolkit to such a device via a wireless communication network. The Shanahan reference is directed toward downloading digital information to a remote device. The Kamada reference is directed toward providing server based storage for a remote device. Accordingly, Shanahan teaches providing data to a handset while Kamada teaches receiving data from a handset – these teachings oppose each other.

There are very significant differences between providing data to a handset and receiving data from a handset. The mechanics of where the data is ultimately stored is a primary difference. The teachings of Shanahan require that the server allow a user to indicate what data to download to the handset and then the server must send that data to the handset for storage. In contrast, the teachings of Kamada require that the server store the data on behalf of the handset.

Furthermore, the Office Action states that it would have been obvious to modify Shanahan to include the authenticating a user associated with the handset for the purpose of security as taught by Kamada. No citation from either reference is provided that states such a motivation for combining the references. Additionally, Shanahan

contemplates the user interaction from its programmer device, thereby precluding authentication of a user at the handset. Specifically, Shanahan states in paragraph 30 on page 3:

Although not shown in FIG. 2, programmer 30 preferably has a display screen and a data input device, such as a keyboard associated with it so that a user may, among other things, browse and select files, monitor file transfers, and ensure that device 20 has properly received the selected files.

This passage demonstrates that Shanahan does not contemplate a user at the handset being authenticated by the server. Any modification of Shanahan to include such functionality would require a significant shift away from the basic operating principles of Shanahan.

Because the Office Action itself has not cited any motivation taught by the references themselves to combine the diverse systems of Shanahan and Kamada, Applicant respectfully submits that the only logical connection between the references is the general concept of moving data over a wireless network, and that the cited references are only modified in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicant's own invention characterization, not any modification of Shanahan actually suggested by the references themselves. In general, the combination of references made in the §103(a) rejection appear to be the result of keyword searches as opposed to a true nexus of related ideas in the same field of art.

"Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue....To prevent the use of

hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that would create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453, 1457-1458 (1998).

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited references points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. As previously stated, to modify Shanahan as suggested in the Office Action would require a fundamental change in the basic operation of Shanahan.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claimed invention. To emphasize this lack of teaching, Applicant has modified independent claims 1 and 7 to include additional features not taught by the cited references. Specifically, claim 1 has been amended to clarify that the connectivity toolkit server obtains profile information for a connecting wireless communication device and that the profile information includes a

data storage capacity for the wireless communication device and also includes identification information for a portion of the server hosted data storage area that is reserved for the wireless communication device. Neither Shanahan nor Kamada teach these limitations.

Additionally, claim 7 has been amended to clarify that the utility programs are executed on the wireless connectivity toolkit server and that the wireless communication device is allowed access to upload and download files to and from a portion of the data storage area on the wireless connectivity toolkit server that is reserved for the wireless communication device. Neither Shanahan nor Kamada teach these limitations. Importantly, in Kamada, the server apparatus remains in control of the server based storage. Kamada teaches that the server routes files obtained by a user of the handset to a server based storage area. The handset in Kamada is not allowed upload access to this storage area. Kamada teaches that only the server accesses this storage area, which is used to temporarily house files until they expire.

In summary, the Office Action cites no passages in the references themselves that suggest or provide any motivation to combine the teachings of Shanahan with Kamada. Further, the Examiner has not demonstrated that the modification of the cited references points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. Finally, the combination of Shanahan and Kamada fail to teach the invention claimed in independent claims 1 and 7. Thus, the combination of Shanahan with Kamada fails to make the claimed invention obvious and Applicant respectfully requests that the rejection of independent claims 1 and 7 and their respective dependent claims be withdrawn.

B. New Claims 20 – 28

New dependent claims 20 – 22 have been added to depend from claim 1. These dependent method claims respectively require that the profile information obtained by the connectivity toolkit server includes an account status for the wireless communication device, a communication speed of the wireless communication device, and that the menu of available connectivity toolkit utilities is compressed before being sent to the the wireless communication device, where it is uncompressed before being displayed.

New independent system claim 23 is directed toward an embodiment of the invention that reserves a portion of the data storage on the toolkit server for the wireless communication device and provides access to that portion of the data storage area to both the wireless communication device, via a wireless communication network, and a network enabled device, via a public network. None of the cited references teach such an embodiment of Applicant's invention where an alternative device is allowed access to a reserved data storage area via a second network connection.

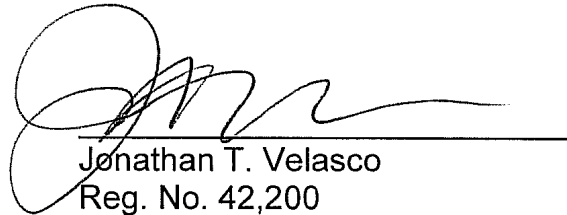
New independent method claim 24 is similarly directed toward an embodiment of the invention that provides access to a reserved portion of the data storage area to both a network enabled device (via a first network) and a wireless communication device (via a second network). Dependent claims 25 – 28 further refine the invention set forth in independent claim 24. Applicant respectfully requests entry and allowance of the new claims 20 – 28.

C. Conclusion

For all the foregoing reasons, allowance of claims 1 – 13 and 20 – 28 pending in the present application is respectfully requested. If necessary, applicant requests under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

Dated: Aug 18, 2006



Jonathan T. Velasco
Reg. No. 42,200

Jonathan T. Velasco
Kyocera Wireless Corp.
Attn: Patent Department
P.O. Box 928289
San Diego, California 92192-8289
Tel: (858) 882-3501
Fax: (858) 882-2485